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IN THE

Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-951

SALEM EQUIPMENT, INC., and
EARL R. HITCHMAN,
Petitioners,

v.

KOCKUM INDUSTRIES, INC.,
Respondent.

BRIEF IN ANSWER TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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ARGUMENT IN ANSWER TO PETITIONER

The question presented by petitioner, "whether a combination-type patent claim may be held valid where it uses functional language at the exact point of alleged novelty," erroneously implies that prior to the Ninth Circuit decision in the present case that question had been uniformly answered in the negative by this Court and by the Second, Seventh and Eighth Circuits, and also erroneously implies that the patent claims here in issue only use functional language at a so-called point of novelty.[1]

1. *Faulkner v. Gibbs*, 338 U.S. 267, 268 (1949). It is doubtful that a combination claim, as distinguished from a "single means" claim or a claim for composition of matter, can properly be considered as having an "exact point of novelty."

The Court below stated that "[i]t is the knife edge which is the heart of the self-opening mechanism in issue and on which appellant relies as imparting novelty." This sharp edge on the tool arms facing toward the oncoming log is specifically recited as an element of the combination in each of the claims in issue. The claims do not attempt to patentably distinguish from the prior art merely by functional statements, but clearly teach those skilled in the art how to utilize a screwing action to self-open the tool arms rather than the camming action which the Ninth Circuit found to have been used in all of the prior art in evidence. It was for this reason that the Ninth Circuit vacated the judgment of the District Court.

In *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364 (1938), this Court was not presented with a combination claim but a product claim for a filament for electric incandescent lamps "composed substantially of tungsten and made up mainly of a number of comparatively large grains of such a size and contour as to prevent substantial sagging and offsetting during a normal or commercially useful life for such a lamp or other device." The decision recognized (P. 371-372) that "[a] limited use of terms of effect or result, which accurately define the essential qualities of a product to one skilled in the art, may in some instances be permissible or even desirable," but this Court then pointed out that "a characteristic essential to novelty may not be distinguished from the old art *solely* by its tendency to remedy the problems in the art met by the patent."

The Court of Customs and Patent Appeals has extensively discussed "functional" claims in *Application of Swinehart*, 439 F.2d 210, 212-213 (C.C.P.A. 1971) and

prior decisions cited therein, and cited the *Wabash* case for an example of claim language so broad that it causes the claim to have a potential scope of protection beyond that which is justified by the specification disclosure. The Court then pointed out that "[t]his ground of rejection is now recognized as stemming from the requirements of the first paragraph of 35 U.S.C. §112."

As previously indicated, the claims here in issue are not worded merely in terms of result to be achieved, but teach a person skilled in the art how to reach that result, and hence are not improperly functional or indefinite. *Mowrey v. Whitney*, 14 Wall. 620, 20 L. Ed. 860, 864 (1872); *Ives v. Hamilton*, 92 U.S. 426, 23 L. Ed. 494, 496, (1876); *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 437 (1902); *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 422 (1907); *Minerals Separation v. Hyde*, 242 U.S. 261, 271 (1916); *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 65-66 (1923). *Georgia-Pacific Corp. v. United States Plywood Corp.*, 258 F.2d 124, 138 (2 Cir. 1958), cert. den. 358 U.S. 884; *Jones Knitting Corp. v. Morgan*, 361 F.2d 451, 454 (3 Cir. 1966); *Lever Bros. v. Proctor & Gamble Mfg. Co.*, 139 F.2d 633, 639-640 (4 Cir. 1943); *Arnold Pipe Rentals Co. v. Engineering Enterprises, Inc.*, 350 F.2d 885, 892 (5 Cir. 1965); *Cold Metal Process Co. v. Republic Steel Corp.*, 123 F. Supp. 525, 539 (D.C.N.D. Ohio), aff'd 233 F.2d 828, 840 (6 Cir. 1956), cert. den. 352 U.S. 955). *Ingersoll Milling Machine Co. v. General Motors Corp.*, 207 F.2d 42, 45 (7 Cir. 1953); *H. H. Robertson Co. v. Klauer Mfg. Co.*, 98 F.2d 150, 153 (8 Cir. 1938); *Locklin v. Switzer Brothers, Inc.*, 299 F.2d 160, 166 (9 Cir. 1961), cert. den. 369 U.S. 861; *Chicago Pneumatic Tool Co. v. Hughes*

Tool Co., 97 F.2d 945, 947 (10 Cir. 1938); *Application of Swinehart*, 439 F.2d 210, 212-213 (C.C.P.A. 1971).

None of the three Circuit Court cases cited by petitioner for the proposition that the decision below conflicts with decisions of other circuits, involve a combination-type patent claim which was held invalid because it allegedly used functional language at the exact point of novelty.

In *Norton Company v. Bendix Corporation*, 449 F.2d 553, 555 (2 Cir. 1971) the Second Circuit correctly pointed out that "Section 112 evinces two objectives: first, that in return for the grant of a patent monopoly the patentee must make sufficient disclosure to enable one skilled in the art to reconstruct the invention; and second, that the patentee describe his invention with sufficient definiteness to enable others to discern the boundaries beyond which experimentation and invention are undertaken at the risk of infringement." The Court then held that the contested claims fell short of meeting the second of these objectives because the testimony of the plaintiff's expert witnesses defined the terms "closely spaced" and a "substantial distance", used in the claims, in a vague and even contradictory manner. Thus, the Court held that the claims were invalid because they were fatally indefinite, and not because they used functional language at the exact point of alleged novelty.

The evidence in the present case clearly proves that the degree of sharpness for the leading edge of the tool arm required to practice the inventions in suit is all within the ready understanding of one reasonably skilled in the art. This is clearly established by the testimony of Nelson (T. 30-31), Gaitten (T. 261-262) and licensee Nicholson (PX

58, p.49: 21-23) that "we, know what works and what doesn't work." For this reason neither the District Court or the Circuit Court held that the claims were indefinite, particularly in view of the descriptions in the patent specifications cited by the Circuit Court in their opinion.

In *Johnson & Johnson v. Kendall Company*, 327 F.2d 391 (7 Cir. 1964) the Court held a patent to an adhesive bandage with smooth facings invalid under Section 103 in view of the prior art, and did not rule that the claims were functional at the point of alleged novelty.

The Eighth Circuit in *Davies-Young Soap Co. v. Nu-Pro Manufacturing Co.*, 273 F.2d 454 (8 Cir. 1959) had under consideration a method claim for dry cleaning a fabric and simultaneously rendering it antistatic. To avoid prior art the patentee argued that the patent claim should be narrowed in light of the specification to add five additional elements not recited in the claim. The Court rejected this argument and cited the *Wabash* case, *supra*, for the analogous proposition that product claims may not be saved by a limitation to products produced in accordance with a process set out in the patent specification. This is not the situation in the present case.

If the *Wabash* case is a holding that prior to the 1952 Patent Act there was an extrastatutory case law prohibition applicable to the Andersson and Leffler claims in the present case, other than the prohibitions presently set forth in the first two paragraphs of Section 112, which was cast aside in 1952 by the adoption of the third paragraph in Section 112, then the Circuit Court decision below is correct in its statement respecting the *Wabash* case. This is very possible in view of the references to the *Wabash* case

in *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 8, 9, 11 (1946), and the fact that most authorities agree that the third paragraph of Section 112 was specifically drafted to permit greater liberality in the use of functional expressions in combination claims. *Application of Fuetterer*, 319 F.2d 259, 264-265, footnote 11 (C.C.P.A. 1963); *Application of Swinehart*, 439 F.2d 210, 212-213 (C.C.P.A. 1971). P. J. Federico in his Commentary on the New Patent Act, 35 U.S.C.A., Vol. 1, p. 25 (1954), stated:

> "The last paragraph of section 112 relating to so-called functional claims is new. . . . It is unquestionable that some measure of greater liberality in the use of functional expressions in combination claims is authorized than had been permitted by some Court decisions, and that decisions such as that in Halliburton Oil Well Cementing Co. v. Walker, 67 S.Ct. 6, 329 U.S. 1, 91 L.Ed. 3 (1946) are modified or rendered obsolete, but exact limits of the enlargement remain to be determined."

However, respondent does not believe that the *Wabash* case was intended to recite extrastatutory case law, and so believes that the Court below erred in commenting that the claims do not meet certain requirements propounded in the *Wabash* decision. Respondent has reached this latter conclusion because the specification and claims in issue clearly meet all of the requirements of the first and second paragraphs of Section 112.

Whether or not the Ninth Circuit was correct in the present case respecting the applicability of the *Wabash* decision prior to 1952, it is clear that the decision below was *not* a holding that a claim does *not* have to meet the requirement of the second paragraph of Section 112 if it contains functional language authorized by the third paragraph thereof.

It is also evident that there is no longer any valid extra-statutory case law respecting functional or indefinite combination-type claims, whatever may have existed prior to the enactment of the third paragraph of Section 112. This has been the position of the Ninth Circuit at least as early as 1961 in *Locklin v. Switzer Brothers, Inc., supra.* In that case the appellant attacked the validity of Switzer's patent on the ground that the limits of melamine in the claimed resin of the patent were expressed in functional language. The patent claims provided that the amount of melamine shall be "an amount . . . sufficient to render said condensation product substantially insoluble in aromatic hydrocarbon solvents but insufficient to render it thermosetting." Since the novelty in the patented resin was that it is both thermoplastic and insoluble, the appellant contended that the above claim language violates a rule against the use of functional language at the precise point of novelty."

The Ninth Circuit rejected the appellant's argument in the *Locklin* case as follows at pp. 165-166 quoting extensively from the *Wabash* case:

> "In our case Switzer, in justification of the functional language, points out that the alternative would have been to state the critical lower limits precisely. This was done in the examples set forth in the specification. Switzer points to the fact that of the considerable number of melamine compounds encompassed by the patent, each has a different critical limit. It asserts that this renders it wholly unreasonable to expect the claims to be specific in this respect or to expect any further specificity than that which appear in the examples given.
>
> "In the General Electric case [Wabash case], the effect of the functional language was to broaden the claim to include all grains of whatever size or shape

so long as they would accomplish the desired result. In our case the critical area is not enlarged in such a fashion. The critical point remains the same for each melamine compound used. It simply is not specified. But whether specified or unspecified the scope of the claim is precisely that of the invention.

"Nor can it be said that this failure to specify the critical limit precisely results in a fatal vagueness of description. The claim must be sufficiently clear to allow others to reproduce the result at the end of the monopoly period and to enable contemporary inventors to ascertain whether or not they are infringing.

"Upon this point the district court concluded:

> " 'When the general description, the specific examples, and the claims are read together, the invention is so plainly defined that no one skilled in the art should have any difficulty in practicing it.'

"The record supports this statement. There is testimony to the effect that 'sufficient malamine to render the resin substantially insoluble' is a simple, clear test for an ordinary chemist to perform and one which does not require extensive experimentation in order that the precise critical limits be ascertained in a particular case. Under such circumstances, the fact that some preliminary testing is required does not render the claim invalid for vagueness. Mineral Separation, Limited v. Hyde, 1916, 242 U.S. 261, 37 S. Ct. 82, 61 L. Ed. 286."

In view of the foregoing detailed discussion in the *Locklin* case, and other portions of that decision, and like remarks by this Court in *Eibel Process Co. v. Minnesota & Ontario Paper Co. supra,* at 65, and the other Supreme Court and Circuit Court cases cited therewith earlier in this brief, even if the Ninth Circuit erred in the present case in stating that the claims in issue would not have met the requirements of the *Wabash* case, such will not create problems in the proper administering of Section 112 or in

obtaining that understanding of the claims in suit necessary for further proceedings in this case.

CONCLUSION

For several reasons set forth above, the decision below does not conflict with decisions of this Court or decisions of other Circuits, and will not create problems in the administering of Section 112 or in the further trial of this case. Accordingly, the petition for writ of certiorari to the United States Court of Appeals for the Ninth Circuit should be denied.

Respectfully submitted,

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REPLY TO BRIEF IN ANSWER TO A PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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Respondent's brief avoids coming to grips with the four reasons for granting the writ of certiorari set forth in the petition. The principal argument in the brief is one going to the merits of the case, i.e., that the claims of the two patents in suit, Andersson and Leffler, do not "patentably distinguish from the prior art merely by functional statements" (Resp. Br., p. 2).

Respondent's concentration on such an argument supports the petition, and underscores the importance of correcting the erroneous decision of the Ninth Circuit.

The basis for the Ninth Circuit's reversal of the District Court's holding that both patents were in-

valid on the ground of anticipation, was its determination that both patented devices use a so-called "screwing action"*, and the devices shown in the prior art patents disclose only a "camming action".

In trying to identify what structural differences between the patented and prior art devices would lead to these supposedly different performances, the court of appeals correctly recognized that the only possible difference must be in the construction of the alleged "sharp edge" of the patented devices—the edge intended for engaging the end of an oncoming log. This edge is what the court referred to as "the heart of the self-opening mechanism in issue . . . on which appellant [respondent] relies as imparting novelty." (Pet. App., p. A-3). And, with respect to this edge, the court went on to say:

> "However, at this critical point of novelty the claims of the patents revert to descriptions in terms of function." (Pet. App., pp. A-3-4).

The court then went on to hold that this fatal defect, under *General Electric Co.* v. *Wabash Appliance Corp.*, 304 U.S. 364 (1938), had been cured by the third paragraph of 35 U.S.C. § 112. This means that the second paragraph of § 112, which has been substantially the same for more than one hundred years,

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* That determination was obviously wrong because none of the Leffler claims mentions anything about "screwing action". Even if we assume that some of the claims mention "screwing action", and that such functional language could support patentability, the Leffler claims are still invalid in view of the earlier disclosure of the same invention in claim 12 of the Andersson patent which specifically refers to "screwing action".

should be disregarded in view of the third paragraph that was added in 1952.

Even if the court could disregard the second paragraph of § 112 in favor of the third paragraph, the claims here in issue must still fall. The specifications of the patents are just as vague and indefinite as are the claims. They provide us with no objective standard for determining when the log-engaging edge of a tool is "sharp" so as to be distinguishable from prior art tool edges. There is simply no structural definition of the term "sharp" anywhere in the patents. A reading of those portions of the patents quoted in footnotes 2 and 3 of the Ninth Circuit's opinion confirms the indefiniteness of the word "sharp" as used by the patentees (Pet. App., pp. A-4-6).

The public has no way of determining what the limits of the alleged inventions are, so that someone who wishes to avoid these patents will know how to build debarker tools without "sharp" log-engaging edges.

Respondent's admission (Resp. Br., p. 6) that the Ninth Circuit incorrectly applied the *Wabash* case supports the petition. The fact that in 1961, in *Locklin* v. *Switzer Brothers, Inc.*, 299 F.2d 160 (9 Cir., 1961), that court may have correctly understood *Wabash*, does not remedy the erroneousness of, or the confusion caused by, the present decision of the Ninth Circuit.

Respondent's brief does not, because it cannot, refute the argument that there is a direct conflict be-

tween the decision below of the Ninth Circuit and those of this Court in *Wabash* and *United Carbon Co.* v. *Binney & Smith Co.*, 317 U.S. 228 (1942). With respect to the Second, Seventh and Eighth Circuit decisions referred to in the petition, it is clear that in those circuits a combination-type claim, which uses functional language at the alleged point of novelty, would be invalidated. Respondent's attempts to distinguish these cases on their facts is beside the point.

On pages 2-4 of respondent's brief, references are made to a number of cases in various circuits, and particularly to the discussion of functional claims by the Court of Customs and Patent Appeals in *Application of Swinehart*, 439 F.2d 210 (C.C.P.A., 1971). That decision is far less pertinent than *Application of Hammack*, 427 F.2d 1378 (C.C.P.A., 1970). In *Hammack* the court specifically dealt with the requirements of the second paragraph of § 112, which requirements are precisely those that are here in issue. The court had the following to say (427 F.2d at 1382):

> "All provisions of the statute must be complied with in order to obtain a patent. The requirement stated in the second paragraph of section 112 existed long before the present statute came into force. Its purpose is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. Compare United Carbon Co. v. Bin-

ney & Smith Co., 317 U.S. 228, 63 S. Ct. 165, 87 L. Ed. 232 (1942), Kaiser Industries Corp. v. McLouth Steel Corp., 400 F.2d 36 (6th Cir. 1968)."

The petition for a writ of certiorari should be granted.

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